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OFFICE OF PETITIONS

In re Application of :
DuMoutier et al. :
Application No. 09/626,617 : ON PETITION
Filed: 27 July, 2000 :
Attorney Docket No. LUD 5664 US :

This is a decision on the petition, filed on 21 February, 2003, under 37 CFR 1.137(a), and, in the alternative under 37 CFR 1.137(b) to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The application became abandoned on 30 June, 2002, for failure to timely file an Appeal Brief in triplicate in response to the Notice of Appeal filed on 29 April, 2002 (certificate of mailing date 18 April, 2002) which set a two (2) month period for reply. An amendment after final rejection was filed on 9 July, 2002, but was determined not to place the case in *prima facie* condition for allowance. The petition requesting reconsideration of the Examiner's decision not to enter the amendment after final rejection filed on 30 September, 2002, was dismissed on 11 February, 2003. Notice of Abandonment was mailed on 14 February, 2003.

Petitioners assert unavoidable delay in that they believed that the petition filed on 30 September, 2002, would be granted or at least decided within the extendable period for filing a response to the Notice of Appeal.

PETITION UNDER 37 CFR 1.137(a)

A grantable petition to revive an abandoned application under 37

CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) the petition fee as set forth in § 1.17(1);

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

This petition lacks item (3) above.

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to be "unavoidable".¹ Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or

¹35 U.S.C. § 133.

imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.²

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).³ Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.⁴

The showing of record is insufficient to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). In this regard, petitioners should note that the only proper reply to a Notice of Appeal is a the filing of an Appeal Brief in triplicate, a Request for Continued Examination (RCE), or a continuing application. The abandonment takes place by operation of law for failure to timely submit a proper reply to an Office action.⁵ This rule clearly indicates that the mere filing of a petition does not save the application from abandonment. Only the filing of a proper reply to the Notice of Appeal. By not filing a timely and proper reply to the Notice of Appeal, petitioners assumed the risk that the application would become abandoned if the petition was not before a deciding official within the period for reply to the Notice of Appeal.

²In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

³See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

⁴Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

⁵MPEP 711.03(c). 37 CFR 1.135. See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 299-30 (CCPA 1964); Krahn v. Comm'r, 15 USPQ2d 1823, 1824 (E.D. Va. 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1984).

Thus, the application became abandoned due to petitioners' failure to file a Notice of Appeal, RCE and submission, or continuation application prior to the expiration of the time period for reply to the final Office action and not because the amendment was misplaced by the Office or delayed in the mail during the statutory time period for reply or any other error on the part of the Patent and Trademark Office.

In summary, petitioners have not established unavoidable delay because the showing of record is that no proper reply to the Notice of Appeal filed on 29 April, 2002, was timely filed.

As petitioners have presented no showing of unavoidable delay, the petition under 37 CFR 1.137(a) will be dismissed.

PETITION UNDER 37 CFR 1.137(b)

The petition is granted.

The petition fee of \$650.00 will be charged to counsel's deposit account. Pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the \$920.00 extension of time fee submitted on 7 May, 2002, was subsequent to the maximum period obtainable for reply, this fee is unnecessary and will be credited to counsel's deposit account.

Therefore counsel's deposit account, No. 50-0624, will be charged a total of \$650.00, as authorized on the CPA request transmittal form.

MPEP 706.07(h) states that in the event that an applicant files a request for a CPA of a utility or plant application that was filed on or after 29 May, 2000 (to which CPA practice no longer applies), the Office will automatically treat the improper CPA as an RCE of the prior application (identified in the request for CPA). As the present application was filed after 29 May, 2000, CPA practice does not apply to this application. Therefore, the improper CPA and preliminary amendment filed with the preliminary amendment will be treated as an RCE and the required submission under 37 CFR 1.114.

The application is being forwarded to Technology Center 1600 for processing of the RCE and amendment filed with the present petition.

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Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.

A handwritten signature in black ink, appearing to read "D Wood", is positioned above the typed name.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions